

## REMARKS

### Claim Status

Claims 1-2 and 4-18 are pending in the present application. No additional claims fee is believed to be due.

### Interview Summary

Applicants would like to thank Examiner Hand for extending Applicants' attorney the courtesy of a telephone interview on March 17, 2009. As discussed during the interview, it is Applicants' position that the combination of Nakahata in view of Malowaniec does not teach or suggest an extensibility controlling means that exerts a tension force of greater than or equal to 125 grams/25mm when the chassis layer extends beyond 20%, and that one of ordinary skill in the art would not be motivated to modify Nakahata to provide the extensibility controlling means recited in claim 1 of the present application. In view of the interview and the discussions held therein, Applicants respond below to the rejections raised by the Office.

### Rejection Under 35 USC §103(a) Over Nakahata in view of Malowaniec

Claims 1-18 have been rejected under 35 USC §103(a) as being unpatentable over U.S. Pat. No. 5,873,868 to Nakahata, et al. (hereinafter "Nakahata") in view of U.S. Pat. No. 6,049,915 to Malowaniec (hereinafter "Malowaniec"). Applicants respectfully traverse the rejection.

To establish a *prima facie* case of obviousness under 35 U.S.C. §103, the Office must show that all of the claim elements are taught or suggested in the prior art. *See, e.g., CFMT, Inc. v. Yieldup Int'l Corp.*, 349 F.3d 1333, 68 U.S.P.Q.2D 1940 (Fed. Cir. 2003).

Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. (*KSR v. Teleflex, Inc.*, 127 S. Ct. 1741 (2007) citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

Nakahata is directed to a disposable diaper comprising an elastically extensible topsheet that has a plurality of slits extending through the topsheet. (Nakahata, Abstract). Malowaniec is directed to a disposable item of clothing that comprises an essentially inelastic layer of a soft, flexible and plastic material; and a layer of elastic material extending over at least a partial region of the inelastic layer. (Malowaniec, Abstract). The inelastic layer includes a plurality of incisions therethrough. (*Id.*).

The Office Action asserts that the article of Nakahata as modified by Malowaniec discloses an extensibility controlling means in the form of elastic waist feature. (The Office Action, page 2). The Office Action states that “Nakahata discloses a material for the elastic waist feature that is identical to a material disclosed by applicant for the claimed extensibility control means, Nakahata certainly fairly suggest an extensibility controlling means . . . exerting the recited tension force, as such a property is an inherent property of a material. (*Id.*). Applicants respectfully disagree with the Office’s interpretation of the scope and content of Nakahata.

First, Applicants would like to point out that Nakahata does not disclose any specific structural or material characteristic of an elastic waist feature. Rather Nakahata merely discloses that “the elastic waist feature may be constructed in a number of different configurations . . . .” (Nakahata, col. 8, lines 9-10). Nakahata then lists several patents that allegedly disclose elastic waist feature configurations. (*Id.* at col. 8, lines 11-20). Thus, Applicants submit that Nakahata does not provide any specific teaching or suggestion as to a particular waist material or configuration, which would reasonably lead one of ordinary skill in the art to provide the extensibility controlling means recited in claim 1 of the present application.

Second, the Office Action has provided no evidence or reasoning to support an assertion that one of ordinary skill in the art would reasonably select a particular material and/or configuration for an elastic waist out of the potentially vast number of such materials and/or configurations to provide the particular extensibility controlling means recited in claim 1 of the present application.

As pointed out above, the combination of Nakahata and Malowaniec does not expressly disclose the desirability of the extensibility controlling means as recited in claim 1 of the present application. Therefore, in order for the Office Action to make a *prima facie* case of obviousness, the Office must show, without the use of improper hindsight, that one of ordinary skill in the would first recognize that the elastic waist feature of Nakahata is suitable for use as an extensibility controlling means. Then, after making the requisite leap of logic, the skilled artisan must make an even greater leap of logic by selecting an elastic waist feature that exerts a tension force of greater than or equal to 125 grams/25mm when the chassis layer extends beyond 20%. Applicants submit that there is no evidence to reasonably support the position in the Office Action that one of ordinary skill in the art would be able to provide Applicants claimed extensibility controlling means based on the exceedingly general disclosure of Nakahata.

Applicants are unable to find any disclosure in the Office Action that points out where in Malowaniec there is disclosure to overcome the lack of teaching or suggestion of Nakahata.

In view of the foregoing, it is Applicants' position that the combination of Nakahata and Malowaniec do not teach or suggest each and every element recited in claim 1 of the present application or any claim depending therefrom. Accordingly, Applicants respectfully request that the rejection of claims 1-2 and 4-18 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

#### Conclusion

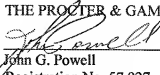
This response represents an earnest effort to place the present application in proper form and to distinguish the invention as claimed from the applied reference(s). In view of the foregoing, entry of the amendment(s) presented herein, reconsideration of this application, and allowance of the pending claim(s) are respectfully requested.

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Customer No. 27752

Respectfully submitted,

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